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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/117,795	11/10/1998	MITSUO SADO	CU-1758RJS	4079
7590 03/23/2004 WARREN R. BOVEE, ESQ. JOHNSON DIVERSEY, INC. 8310 16TH STRET, M/SS 509 P.O. BOX 902 STURTEVANT, WI 53177-0902			EXAMINER GARRETT, DAWN L	
			ART UNIT 1774	PAPER NUMBER
DATE MAILED: 03/23/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/117,795	SADO, MITSUO	
	Examiner	Art Unit	
	Dawn Garrett	1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) 5-7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>8-20-1999</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 16, 2004 has been entered.

Response to Amendment

2. This Office action is responsive to the amendment filed with the request for continued examination dated January 16, 2004. Claims 5-7 were added and claims 1-7 are pending.

3. Newly submitted claims 5-7 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The new claims are method claims and the liquid composition of claims 1-4 can be used in a method other than the methods recited in new claims 5-7. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 5-7 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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5. Claims 1-4 rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

6. In claim 1, clear support for the added negative limitation "said composition being free of ethylene glycol mono-butyl ether" has not been found in the specification. While the specification does show a comparative example comprising ethylene glycol mono-butyl ether, the specification does not expressly state ethylene glycol mono-butyl ether is not in the instant composition. Accordingly, the added limitation is considered to be new matter. [The examiner notes that claim 1 was similarly rejected in paper no. 32 (mailed December 5, 2002), but the rejection was withdrawn when applicant deleted the negative limitation in the amendment received June 16, 2003. Claim 1 presented in the most recent amendment of January 16, 2004 is different from claim 1 in the previous amendment received June 16, 2003.]

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-4 are rejected under 35 U.S.C. 103(a) as obvious over JP 63-069897 A (see full English translation for citation references). Japanese patent 63-069897 describes a cleaner composition comprising 5-95 % of one or more amines of mono-, di-, and triethanol amines, 0.2-50 % of one or more high boiling point solvents comprising diethylene glycol monobutyl ether

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and benzyl alcohol used for removal of heavy dirt attached to hard surfaces. Instant claim 1 is drawn to "A releasing agent composition...which comprises as essential components...(A) 5 to 75% by weight of a water-soluble organic solvent represented by the formula $C_4H_9-O-(CH_2CH_2O)_nH$ where n is an integer of 2 or 3". Present claim 2 is drawn to a composition wherein (A) may be diethylene glycol monobutyl ether. JP 63-069897 clearly reads on instant component (A) by disclosing diethylene glycol monobutylether (see page 2 of translation, lines 4 and 5 of part (b)). Per the instant claim 1 requirement of 15 to 40% by weight of benzyl alcohol, JP 63-069897 also clearly discloses benzyl alcohol as a component of the composition (see page 2 of the translation, line 5 of (b)). Applicant recites an amine compound in instant claim 1 and a specific amine, alkanolamine, in instant claim 3. JP 63-069897 clearly discloses alkanolamines such as monoethanol amine, diethanol amine, and triethanol amine as part of the composition (see page 2 of translation, line 3 of part (a)). In addition to the JP 63-069897 teaching of all components recited in instant claim 1 parts (A) – (C), the component amounts taught for the JP 63-069897 composition encompass and/or overlap with the ranges recited in instant claim 1. Applicant requires 10 to 20% by weight of an amine compound, component (C). JP 63-069897 teaches 5 to 95 parts of one or more amines (see page 2, lines 1 and 2 of part (a)), which clearly encompasses the required range of 10 to 20% by weight. Applicant requires 15 to 40% by weight of benzyl alcohol (component (B)) and 5 to 75% by weight of a water-soluble organic solvent represented by the formula $C_4H_9-O-(CH_2CH_2O)_nH$ where n is an integer of 2 or 3. JP 63-069897 teaches 0.2 to 50 parts of a combination of solvents including diethylene glycol monobutylether and benzyl alcohol (see page 2, lines 4 and 5 of part (b)). The JP 63-069897 teaching of 0.2 to 50 parts of a combination of diethylene glycol monobutylether and benzyl

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alcohol clearly encompasses and/or overlaps with the required amounts of 15 to 40% of benzyl alcohol and 5 to 75% by weight of a water-soluble organic solvent such as diethylene glycol monobutyl ether. Per instant claim 4, the working examples taught by JP 63-069897 describe diluting the cleaning compositions in water (see “Working Examples” page 7 of translation). It would have been obvious to one of ordinary skill in the art at the time of the invention to produce the claimed composition in the recited proportions of ingredients, since each of the claimed components in the claimed weight ranges are disclosed by JP 63-069897.

Response to Arguments

9. Applicant states “The JP reference is directed to a different art area than the present invention.” The examiner respectfully submits the preamble of claims 1-4 under consideration is drawn to “a liquid composition”. The phrase “for use in removing an aqueous polymer floor polish” is considered to be an intended use and is not considered to be patentably significant. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

With regard to applicant’s argument that “the JP reference teaches that all of the high boiling solvents are equivalent to one another for the purposes of the JP invention and that only one is needed, e.g. Example 1 of the JP reference” and “the reference teaches that ethylene glycol monoethyl ether and ethylene glycol monobutyl ether are suitable solvents and such solvents are expressly excluded from the present claims”, the examiner submits JP 63-069897 does not require the composition comprise ethylene glycol mono-butyl ether, but rather recites

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the solvent in a Markush group as a possible solvent. The reference recites as component (b) (see second page of translation) “0.2 to 50 weights parts, and preferably 2 to 20 weight parts, of **one or more** high-boiling solvents selected from ethylene glycol monoethyl ether, diethylene glycol monoethyl ether, ethylene glycol monobutyl ether, **diethylene glycol monobutyl ether**, and **benzyl alcohol**”. The teaching clearly does not require that ethylene glycol monoethyl ether be present and accordingly, applicant’s added negative limitation has not overcome the teaching of JP 63-069897. In addition, JP 63-069897 does not teach only one high-boiling solvent is used, but clearly teaches “one *or more* high-boiling solvents” are used. The examiner respectfully maintains all ingredients as well as amounts of ingredients of the instant claims are clearly taught by JP 63-069897 and accordingly, JP 63-069897 renders obvious the instant composition.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dawn Garrett whose telephone number is 571-272-1523. The examiner can normally be reached Monday through Friday during normal business hours. Please allow the examiner twenty-four hours to return your call.

If reasonable attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly, can be reached at 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DAWN GARRETT
EXAMINER
ART UNIT 1774

D.G.
March 16, 2004